REMARKS

[0001] Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 91-110 are currently pending.

Formal Request for an Interview

[0002] If the Examiner's reply to this communication is anything other than allowance of all pending claims, then I formally request an interview with the Examiner. I encourage the Examiner to call me—the undersigned representative for the Applicant—so that we can talk about this matter so as to resolve any outstanding issues quickly and efficiently over the phone.

[0003] Please contact me to schedule a date and time for a telephone interview that is most convenient for both of us. While email works great for me, I welcome your call as well. My contact information may be found on the last page of this response.

Substantive Matters

Claim Rejections under § 103

[0004] The Examiner rejects claims 91-110 under § 103. For the reasons set forth below, the Examiner has not made a prima facie case showing that the rejected claims are obvious.

[0005] Accordingly, Applicant respectfully requests that the § 103 rejections be withdrawn and the case be passed along to issuance.

[0006] The Examiner's rejections are based upon the following references in combination:

- **Lau 6,772,212:** *Lau* US Patent No. 6,772,212 (issued August 3, 2004); and
- **Li 6,345,279:** *Li* US Patent No. 6,345,279 (issued February 5, 2002).

Obviousness Rejections

Lack of *Prima Facie* Case of Obviousness (MPEP § 2142)

[0007] Applicant disagrees with the Examiner's obviousness rejections. Arguments presented herein point to various aspects of the record to demonstrate that all of the criteria set forth for making a *prima facie* case have not been met. To establish *prima facie* obviousness of a claimed invention, all of the claim recitations must be taught or suggested by the prior art[1] and "all words in a claim must be considered in judging the patentability of that claim against the prior art."[2] Further, if prior art, in any material respect teaches away from the claimed invention, the art cannot be used to support an obviousness rejection.[3] Moreover, if a modification would render a reference unsatisfactory for its intended purpose, the suggested modification / combination is impermissible.[4]

Based upon Lau 6,772,212 and Li 6,345,279

[0008] The Examiner rejects claims 91-110 under 35 U.S.C. § 103(a) as being unpatentable over Lau 6,772,212 and Li 6,345,279. Applicant respectfully traverses the rejection of these claims and asks the Examiner to withdraw the rejection of these claims.

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[1] *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)

[2] *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)

[3] *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed Cir. 1997)

[4] See MPEP § 2143.01

Independent Claim 91

[0009] Applicant submits that the combination of Lau 6,772,212 and Li 6,345,279 does not teach or suggest at least the following elements as recited in this claim:

- "the circuitry determines whether or not the format of the corresponding music track is compatible with the corresponding music renderer such that the music renderer can render music from the music track;" and
- "in response to a determination that the format is not compatible with the music renderer, reformats the music track to a format that is compatible with the music renderer[.]"

[0010] The Examiner indicates (Action, p. 3-6) the following with regard to this claim:

> Regarding Claim 91, Lau discloses:
> An electronic device for communication with a user (i.e. computer system; Fig. 1) comprising:
> circuitry that includes a processor (processor; Col. 4); and a set of software instructions that (any of the software to run the system or produce the GUI shown in the figures), when executed by the processor, causes the circuitry to:
> display a graphical user interface that includes a library (1202, 1204 and 1206) and that graphically depicts music renderers (Fig. 13 element 1202 which lists the devices that can be communicated with to store tracks).
> Lau does not explicitly disclose that the library is a hierarchical library tree or the music renderers are depicted as nodes. However, graphical user interfaces for transferring music between portable devices (and non portable devices) are notoriously well known to be

shown in a hierarchical format. For example Katz (US 6,356,971) shows a computer with a windowed GUI that includes a main PC connected to remote music devices (Figs. 4A–4B). Oweyer (US 6,671,567) shows another hierarchical windowed GUI on a computer communicating with a portable audio storage and playback device (Fig 8). Further, the Windows Operating System includes the explorer program which typically shows the various storage devices one can use to store information or manipulate/move.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lau's displays (1202, 1204, 1206) to display as a hierarchical library. One would have been motivated to do so to provide an easier to operate GUI. Hierarchical trees showing files and allowing manipulation have been implemented in systems very widespread (such as MS Windows). As a result user's are familiar with the hierarchical format and thus the device would be easier to use.

The modification further discloses:

wherein the music renderer node identifies a music renderer coupled to the device and (displaying the connected devices in 1202) and includes information about the music renderer (the device connected can be edited, thus indicating that information must be provided to the computer system in order for editing to occur; editing shown in col. 13), and the music item node includes an icon identifying a music track stored on the medium of the device (the tracks presented in 1206; also col. 13).

The modification of Lau does not disclose the remaining limitations of claim 91.

In a similar field of endeavor (media transferring between computer devices) Li discloses a system that includes a device that provides capability information to a server device which then is able to transcode the media data to a format acceptable to the device; Fig. 3).

Applying this to the invention disclosed by Lau teaches:

in response to moving the icon from the music item node to the music renderer node (i.e. dragging music files; col. 13), the circuitry:

determines whether or not the format of the corresponding music track is compatible with the corresponding music renderer such that the music renderer can render music from the track (connecting a playback device {such as the one taught by Dweyer example only, many possible} to the computer system, the client profile 310 of the device as modified by Li is provided to the system, which shows the capabilities and resources of the device; col. 6 of Li};

in response to a determination that the format is not compatible with the music renderer, reformats the music track to a format that is compatible with the music renderer; and moves the music track to the music renderer (i.e. Li teaches a content adaptation process 350 uses the profile to select the version of the media that best satisfies the particular client profile, the client, which is the device of Lau, then receives the customized media; col. 6 of Li}.

It would have been obvious to one of ordinary skill in the art to apply the teachings of Li to the device taught by Lau. Lau recognizes that multiple devices may be connected to the system. Li recognizes that there exists a wide range of devices that can provide media content to user. These device contain numerous properties and it would be desirable to optimally match the media to the capabilities of the client device requesting it; cols. 1 and 2.

[0011] Claim 91 recites "the circuitry determines whether or not the format of the corresponding music track is compatible with the corresponding music renderer such that the music renderer can render music from the music track;" and "in response to a determination that the format is not compatible with the music renderer, reformats the music track to a format that is compatible with the music renderer[.]" That is, music tracks that are rendered in a first format, such as an Audio CD format (e.g., Red Book format,) that may not properly play on an MP3 player, can be rendered in a second format (e.g., a specific MP3 format) such that the music track will play on the second device.

[0012] As correctly acknowledged by the Examiner, Lau 6,772,212 does not teach these recitations of claim 91. However, Li 6,345,279 does not cure this deficient teaching as contended by the Examiner.

[0013] Li 6,345,279 is directed to an apparatus that adapts Web documents for rendering on different computing systems. In specific, Li 6,345,279 teaches a transcoding process that can recognize a multimedia document having content, such

as text or video and then change the content such that it may then be rendered on a device of less computing ability. For example, a Web document having video may not play on a simple pager. Thus, the system of Li 6,345,279 may transcode the video feed such that just still images are displayed at the pager. In essence, the content is changed to a simple format for a simple device. See generally, col. 2 line 19 to col. 3, line 18. Examples disclosed in Li 6,345,279 include changing the special size of an image, changing the size of text; changing the size of video images.

[0014] This overly simplistic view of content files, however, simply does not compare to the more complex nature of dealing with differing formats of music files. Music files must necessarily be rendered in a proper format for playback or else the music loses all meaning. One cannot make the music "smaller" or have less text. Through compression, the size of a music file may be made smaller, but the underlying music track itself is still rendered in the same recognizable manner. Thus, even though a music track may be changed from a format suitable for an MP3 player from a format suitable for an Audio CD player, the fact remains that the underlying music itself is still same.

[0015] Li 6,345,279 does not show any cognizance or recognition of differing music file formats. The closest Li 6,345,279 comes to teaching or even suggesting such a transformation is an application of changing an audio file to text. See generally col. 5, lines 26-63 of Li 6,345,279. It simply does not follow that a music file can be converted to text. No person of ordinary skill in the art would look to a system that describes converting an audio file (presumably a speech file, like a voice mail message) into a text file. Somehow, Tchaikovsky's "*Overture of 1812*" is far less impressive when converted to text.

[0016] Li 6,345,279 cannot possibly be construed to teach or even suggest "in response to a determination that the format is not compatible with the music renderer, reformat the music track to a format that is compatible with the music renderer;" as recited in claim 91. Consequently, no prior art of record, whether considered alone or in any permissible combination, teaches or suggests at least this recitation of claim 91.

[0017] Moreover, applicants submit that the Office Action is using hindsight reasoning. As a matter of law, obviousness may not be established using hindsight obtained in view of the teachings or suggestions of the applicants.[1] To guard against the use of such impermissible hindsight, obviousness needs to be determined by ascertaining whether the applicable prior art contains any suggestion or motivation for making the modifications in the design of the prior art article in order to produce the claimed design. The mere possibility that a prior art teaching could be modified or combined such that its use would lead to the particular limitations recited in a claim does not make the recited limitation obvious, unless the prior art suggests the desirability of such a modification.[2]

[0018] As shown above, the combination of Lau 6,772,212 and Li 6,345,279 does not teach or suggest all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

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[1] *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

[2] *See In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Dependent Claims 92-95 and 102-104

[0019] These claims ultimately depend upon independent claim 91. As discussed above, claim 91 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

[0020] For example, claim 93 recites "the hierarchical library tree graphically depicts more than one music renderer node, wherein each music renderer node identifies a respective one of a plurality of music renderers coupled to the device." The prior art of record simply does not show any cognizance of differing music renderers that may each, in turn, have different rendering formats for music files. Applicant submits that claim 93 is allowable over the prior art of record for at least this additional reason.

[0021] As another example, claim 94 recites "the music renderer includes at least one of a stationary device, a stereo system, a portable device, a Diamond RIO, a RCA Lyra, a portable radio, and a personal display adaptor." Notwithstanding the claim that the prior art of record teaches these devices, it simply does not follow that the prior art of record shows any cognizance of the unique nuances of dealing with differing formats for music tracks according to different devices. To follow such logic, one would then assume that all new technologies created for powering a vehicle are rendered obvious because the internal combustion engine accomplishes the moving of a vehicle. Therefore, the logic presented in the Office Action would consider electric vehicles, hydrogen vehicles and natural gas vehicles as obvious variations of a gas powered vehicle because all of these many examples are obvious variations of each other. Such broad, conclusory statements do not adequately address the issue of

motivation to combine, are not evidence of obviousness, and therefore are improper as a matter of law.[1] Applicant submits that claim 94 is allowable over the prior art of record for at least this additional reason.

Independent Claim 96

[0022] Applicant submits that the combination of Lau 6,772,212 and Li 6,345,279 does not teach or suggest the recitations of claim 96 for at least the same reasons as discussed above with respect to claim 91. Claim 96 is directed to a method similar to the device of claim 91. As shown above, the combination of Lau 6,772,212 and Li 6,345,279 does not teach or suggest all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

Dependent Claims 97-100 and 105-108

[0023] These claims ultimately depend upon independent claim 96. As discussed above, claim 96 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

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[1] *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)

Independent Claim 96

[0024] Applicant submits that the combination of Lau 6,772,212 and Li 6,345,279 does not teach or suggest the recitations of claim 101 for at least the same reasons as discussed above with respect to claim 91. Claim 101 is directed to a computer-readable medium similar to the method of claim 96. As shown above, the combination of Lau 6,772,212 and Li 6,345,279 does not teach or suggest all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

Dependent Claims 109-110

[0025] These claims ultimately depend upon independent claim 101. As discussed above, claim 101 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

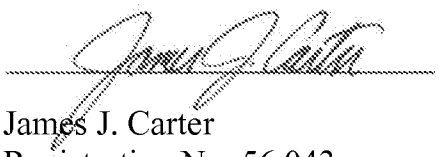
Conclusion

[0026] All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that prevent issuance of this application, the **Examiner is urged to contact me before issuing a subsequent Action**. Please call or email me at your convenience.

[0027] In the event additional fees are due as a result of this amendment, payment for those fees has been enclosed in the form of a check. Should further payment be required to cover such fees you are hereby authorized to charge such payment to Deposit Account No. 07-1897.

Respectfully submitted,

GRAYBEAL JACKSON HALEY LLP



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